

**RESPONSE TO THE FINAL OFFICE ACTION MAILED May 14, 2004**  
**Patent Application No. 09/734,432**

**RESPONSE**

**Remarks**

Applicant *acknowledges* the Amendment received on February 27, 2004 was considered and entered by the Examiner.

Claims 1-20 are pending in the Application. Claim 1, 5, 10 and 16 are in independent format. Applicant now responds to the Examiner's assertions.

The Applicant asks the Examiner carefully consider the comments below with an open mind. If the Examiner carefully and realistically considers the comments below with an open mind she will see that her rejections are improper, violate the holdings of many different court decisions and cannot be maintained.

**Revocation of Prior Power of Attorney**

The Applicant filed a Revocation of Prior Power of Attorney on February 27, 2004, another copy of which is attached. However, the Final Office Action was mailed directly to Applicant instead of the Applicant's Attorney *causing significant delay* in responding to this Final Office Action. The Applicant requests the Revocation of Prior Power of Attorney be recorded and all further correspondence be sent directly to:

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Applicant also request this application be immediately added to the PAIR system for USPTO Customer Number 32097.

**Claim Objections**

The Examiner objected to claims 10, 13 and 18 because of typing mistakes. Claims 10, 13 and 18 have been amended to correct typing mistakes as requested by the Examiner.

**Claim Rejections – Section 112**

The Examiner rejected Claim 13 under 35 U.S.C. §112, 2<sup>nd</sup> ¶. Applicant has a corrected a typing mistake in Claim 13. Applicant requests the Examiner withdraw the Section 112 rejection for Claim 13.

**Section 102 Rejection**

The Examiner rejects Claims 1-4, 12-15 and 16-20 under 35 U.S.C. §102(b) as being anticipated by Davida et al. ("On Enabling Secure Applications Through Off-Line Biometric Identification").

The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

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**Section 102 Response**

The Examiner asserts that "Regarding Claim 1, Davida et al. ("Davida") discloses a body part input means for generating an information signal impressed with characteristics of a body part (Sect 6. and 6.1), an index generation means for dynamically generating one or more indices from the information signal, wherein the one or more indices are created by processing the information signal (Sect. 5.1; para. 3) and a linking means to link at least one of the indices to and identity for the part part (Sect 5.1, Sect. 2.2)."

The Examiner is reminded that a claim is anticipated under 35 U.S.C. §102(b) only if each and every element as set forth in the claim is found either, expressly or inherently described, in a single prior art reference. *Vergeall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claims 1-4, 12-15 and 16-20 as amended do not include each and every element as found in the cited prior art reference. Therefore, the Applicant now requests the Examiner immediately withdraw the §102(b) rejections with respect to Claims 1-4, 12-15 and 16-20. Since these claims are not anticipated they should be immediately allowable in their present form.

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**First Section 103 Rejection**

The Examiner asserts Claims 5, 6 and 8-11 are rejected under U.S.C. §103(a) as being unpatentable over Davida et al. (On Enabling Secure Applications Through Off-line Biometric"). The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

**First Section 103 Response**

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Claims 5, 6, and 8-11 as amended do not teach or suggest all of the claim limitations of the cited prior art reference. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 5, 6, and 8-11. Since these claim are not obvlous, they should be Immediately allowable in its present form.

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**Second Section 103 Rejection**

The Examiner asserts Claim 7 is rejected under U.S.C. §103(a) as being unpatentable over Davida et al. (On Enabling Secure Applications Through Off-line Biometric Identification") as applied to Claim 5 above, and further in view of Canetti (*Towards Realizing Random Oracles: Hash Functions that Hide All Partial Information*). The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

**Second Section 103 Response**

The arguments for Claims 1-6 and 8-20 are incorporated by reference. The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Claims 7 as dependent on amended independent Claim 5 does not teach or suggest all of the claim limitations of the cited prior art reference. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claim 7. Since this claim is not obvious it should be immediately allowable in its present form.

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**CONCLUSION**

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §103 rejections of the claims and pass all of the pending claims 1-20 to allowance.

Respectfully submitted.

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Dated: November 14, 2004

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